

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Kobi Iki et al.	Art Unit :	3739
Patent No. :	7,951,142	Examiner :	Michael F. Peffley
Issue Date :	May 31, 2011	Conf. No. :	4190
Serial No. :	10/766,894		
Filed :	January 30, 2004		
Title :	CARTILAGE TREATMENT PROBE		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION

In a Decision on Request for Reconsideration of Patent Term Adjustment and Notice of Intent to Issue Certificate of Correction (“Decision”) dated August 11, 2011, the United States Patent and Trademark Office (“Office”) granted to the extent indicated herein Patentees’ Application For Patent Term Adjustment (PTA) Under 37 C.F.R. § 1.705(d) filed August 1, 2011, for the above-indicated patent. The Office agreed to adjust a period of time corresponding to Applicant Delay, for a total Applicant Delay of 112 days. The Office did not agree that “B Delay” should not be reduced by 131 days for the period of time under which the application was not undergoing continued examination.

The Office Incorrectly Excluded a Period of Time from B Delay that Does Not Correspond to
Time Consumed by Continued Examination

The Decision stated that the patent is entitled to 886 days of PTA. Patentees maintain that the patent is entitled to 1,017 days of PTA, for the reasons provided below.

“A Delays” are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt response by the Office. It is Patentees’ understanding that there is no dispute that there were four periods of A Delay (March 31, 2005, to May 9, 2006; December 8, 2007, to November 17, 2008; June 27, 2009, to August 21, 2009; and March 24, 2010, to July 7, 2010) for a total of 913 days.

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: September 12, 2011.

“B Delays” are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. Patentees submit that B Delay accumulated for a total of 1,582 days, beginning on January 31, 2007 (the day after the date that is three years after the date on which the application was filed), and ending May 31, 2011 (the date the patent was issued). The Office has excluded from B Delay the number of days corresponding to the period beginning on April 26, 2007 (the date on which a Request for Continued Examination was first filed), and ending on May 31, 2011 (the date the patent was issued). However, this entire period should not be excluded from B Delay because it does not correspond in its entirety to continued examination. The Notice of Allowance Action mailed on January 21, 2011, closed examination of the application on that date. Section 154(b)(1)(B)(i) of Title 35 excludes from B Delay “time consumed by continued examination of the application.” The statute does not provide for exclusion from B Delay of time from the mailing of a Notice of Allowance until issuance (a period during which continued examination did not occur).

The legal issue presented in the preceding paragraph is currently the subject of a civil action against the Office in Abbott Biotherapeutics Corp. v. Kappos, 1:2010cv01853 (D.D.C. filed October 29, 2010). The plaintiff in Abbott Biotherapeutics Corp. v. Kappos has argued that the Office improperly calculated the length of the statutory delay period defined by 35 USC 154(b)(1)(B) by subtracting from the delay period the number of days from the mailing of a Notice of Allowance until issuance (a period during which continued examination did not occur). *In the event that the Office is unwilling to increase PTA for the present patent in the manner requested herein, Patentees request that a final decision on this petition be held in abeyance pending the final resolution in Abbott Biotherapeutics Corp. v. Kappos. A decision in Abbott Biotherapeutics Corp. v. Kappos will likely settle the legal issue that is central to the present petition.*

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Attorney's Docket No.: 00167-0491001 / PT-2634-US-NP

Please apply the \$200 petition fee and any other charges or credits to Deposit Account
No. 06-1050, referencing Attorney Docket No. 00167-0491001.

Respectfully submitted,

Date: September 12, 2011

/Timothy W. Riffe/

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